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Docket No.: B2745.0025  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Heidi Kay et al.

Application No.: 09/216,206

Confirmation No.: 1079

Filed: December 18, 1998

Art Unit: 3622

For: OPTIMIZED INTERNET ADVERTISING  
USING HISTORY TO SELECT SITES

Examiner: J. W. Myhre

INFORMATION DISCLOSURE STATEMENT (IDS)

\* Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

Timing of Filing of the Information Disclosure Statement:

- This IDS is being filed before the First Office Action<sup>1</sup>.
- This IDS is being filed after the issuance of the First Office Action but before the issuance of a Final Office Action<sup>2</sup>.

11/05/2004 RFEKADU1 00000089 09216206

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<sup>1</sup> The IDS should, where possible, include a certification under 37 C.F.R. §1.97(e).

<sup>2</sup> The IDS *must* include either a certification under 37 C.F.R. §1.97(e) or the fee set forth in 37 C.F.R. §1.17(p).

- This IDS is being filed after the issuance of a Final Office Action but before the payment of the Final Fee<sup>3</sup>.

**Certifications:**

If checked, the undersigned makes the following statement(s):

- Statement under 37 CFR § 1.97(e):

Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement; or

No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

- Statement Under 37 C.F.R. § 1.704(d):

Each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart application less than thirty days prior to the filing of this information disclosure statement.

**Fee Required by 37 C.F.R. § 1.97(c)(2) or 1.97(d)(2):**

- If checked, the fee of \$180.00 set forth in 37 C.F.R. §1.17(p) is attached.

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<sup>3</sup> The IDS *must* include *both* a certification under 37 C.F.R. §1.97(e) *and* the fee set forth in 37 C.F.R. §1.17(p).

**Copies of Information:**

In accordance with 37 C.F.R. §1.98(a), the following are enclosed:

- A legible copy<sup>4</sup> of each document (or relevant portion thereof) is cited in the attached PTO/SB/08.
- With respect to any information which is not in English, a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, is attached. This concise explanation is provided by way of:
  - A translation of the relevant portions of the non-English language information<sup>5</sup>;
  - A statement explaining the relevant portions of the non-English language information;
  - A copy [and, where not in the English language, a translation] of at least the relevant portion(s)<sup>6</sup> of the communication from a foreign patent office in a counterpart foreign application in which the information was cited; or
  - This information is contained in the specification of the present application.
- In accordance with 37 C.F.R. 1.98(d), copies of the cited documents AA to AI are not enclosed as they were provided in application Serial No. 08/787,979 (now U.S. Patent No. 6,285,987) which the present application relies upon for an earlier effective filing date under 35

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<sup>4</sup> A legible copy of the document is not required if (1) the information was previously cited by, or submitted to, the Office and considered by the Office in a prior U.S. application to which this application claims priority, provided that the prior application is properly identified in this IDS, and (2) the IDS submitted in the earlier application complies with 37 C.F.R. § 1.98(a) – (c). This exception does not apply to information cited in an International Application.

<sup>5</sup> 37 C.F.R. §1.98(a)(3)(ii) *requires* that an English language translation be provided when a translation of the document, or portion thereof, “is within the possession, custody or control of, or is readily available to any individual designated in 37 C.F.R. § 1.56(c).”

<sup>6</sup> The relevant portion is that portion which indicates the degree of relevance found by the foreign patent office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. MPEP §609 III A(3).

U.S.C. 120. Copies of all other references are submitted herewith. References with Cite Nos. AK-AM are motions submitted by applicants in an Interference proceeding for the previously mentioned application No. 09/787,979.

**Materiality:**

Whether or not the information and references disclosed in this Information Disclosure Statement is "material" pursuant to 37 CFR 1.56, this submission is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

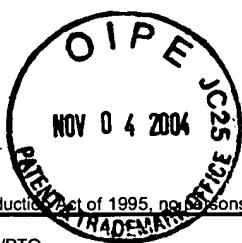
In the event the actual fee is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 50-2215.

Dated: November 3, 2004

Respectfully submitted,

By \_\_\_\_\_  
Ian R. Blum

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PTO/SB/08A (08-03)

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Substitute for form 1449/PTO

## **INFORMATION DISCLOSURE STATEMENT BY APPLICANT**

*(Use as many sheets as necessary)*

Sheet 1 of 3

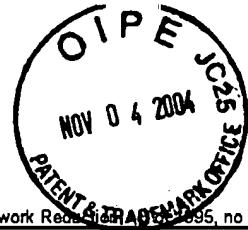
<i><b>Complete if Known</b></i>	
Application Number	09/216,206
Filing Date	12-18-1998
First Named Inventor	David William Roth
Art Unit	3622
Examiner Name	James W. Myhre
Attorney Docket Number	B2745.0025/P0025

<b>Examiner Signature</b>		<b>Date Considered</b>	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Complete if Known**

Substitute for form 1449/PTO				Application Number	09/216,206
				Filing Date	12-18-1998
				First Named Inventor	David William Roth
				Art Unit	3622
				Examiner Name	James W. Myhre
Sheet	2	of	3	Attorney Docket Number	B2745.0025/P0025

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	CA	Frook, John Evans, "Web sites sell ad space through auction--Despite industry skepticism, Individual Inc. and Netscape try out new strategies", Interactive Age, v2, n20, p. 5, 1 page, Jul. 1995	
	CB	Article by Toland, P., entitled "CNET: The Computer Network Unveils Revolutionary Internet Advertising Tool That Allows Customer Banner Ad Delivery Based on Demographic Information", PR Newswire, Dateline: San Francisco, Dec. 6, 1995 (3 pages)	
	CC	"Sites Dip Into Cookies to Track User Info", 2 pgs, Obtained from Internet site <a href="http://www.webweek.com">http://www.webweek.com</a> printed from Internet Aug. 5, 1996	
	CD	"Imgis AdForce Features and Benefits", 12 pgs Obtained from Internet site <a href="http://www.imgis.com">http://www.imgis.com</a> printed from Internet Jul. 28, 1996	
	CE	"About Worldata Worldata Information Marketing Services", 48 pgs. Obtained from Internet site <a href="http://www.worldata.com">http://www.worldata.com</a> printed from Internet Sep. 3, 1996	
	CF	"Focalink Welcome to Focalink" 34 pgs. Obtained from Internet site <a href="http://www.focalink.com">http://www.focalink.com</a> etc. printed from Internet Aug. 8, 1996	
	CG	"Click here for DoubleClick Information Request Form et. seq." 82 pgs, Obtained from Internet site <a href="http://www.doubleclick.net">http://www.doubleclick.net</a> printed from Internet Aug. 4, 1996	
	CH	"Cybertimes Start Ups Plot to make the Web Confortable for Advertisers" 4 pgs Obtained from Internet site <a href="http://www.netgravity.com">http://www.netgravity.com</a> printed from Internet Mar. 28, 1996	
	CI	"Sites Dip Into Cookies to Track User Info", 2 pgs, Obtained from Internet site <a href="http://www.webweek.com">http://www.webweek.com</a> printed from Internet Aug. 5, 1996	

Examiner Signature	Date Considered
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Substitute for form 1449/PTO				<i>Complete if Known</i>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(Use as many sheets as necessary)</i>				Application Number	09/216,206
Sheet	3	of	3	Filing Date	12-18-1998
				First Named Inventor	David William Roth
				Art Unit	3622
				Examiner Name	James W. Myhre
				Attorney Docket Number	B2745.0025/P0025

<b>NON PATENT LITERATURE DOCUMENTS</b>					
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			T <sup>2</sup>
	CJ	PR NEWSWIRE, "Narrowline Announces 'Brought To You By' - An Internet Advertising Transaction System Now Entering Pilot Period", San Fransisco, 12-20-1996 , 2 Pages			
	CK	Bradley J. Bereznak, "Roth Preliminary Motion No. 2", 8-15-2000 , 24 Pages			
	CL	Bradley J. Bereznak, "Roth Preliminary Motion No. 3", 8-15-2000 , 18 Pages			
	CM	Bradley J. Bereznak, "Reply Brief Relating to Roth's Preliminary Motion No. 2", 10-17-2000 , 4 Pages			

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